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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/181,547	10/29/1998	KISSEI MATSUMOTO	286409US6	1034
22850	7590	09/25/2009		
OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, L.L.P. 1940 DUKE STREET ALEXANDRIA, VA 22314			EXAMINER ROJAS, HAJIME S	
			ART UNIT 3627	PAPER NUMBER
			NOTIFICATION DATE 09/25/2009	DELIVERY MODE ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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# Office Action Summary

**Application No.**

09/181,547

**Applicant(s)**

MATSUMOTO, KISSEI

**Examiner**

HAJIME ROJAS

**Art Unit**

3627

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 05 May 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1, 2, 4-28 and 52-61 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 2, 4-28 and 52-61 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/C)
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date: \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_  
Paper No(s)/Mail Date: \_\_\_\_\_

### DETAILED ACTION

This communication is in response to application filed on May 5, 2009.

Claims 1-2, 4-28, 52-61 are pending and presented for examination on the merits.

#### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

**Claims 5-9, 11-16, 21, 22 and 24-28 and 58 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.**

Claims 5-9, 11-16, 22 and 24-28 recite or depend from limitation/s reciting "an intention of the user to make payment" (e.g. claim 5) or "the user is willing to make the payments" (e.g. claim 8).

Claim 21 recites "wherein said controller includes a discriminating unit, based on the supplementary data appended to the sent data, configured to indicate that the data is data newly stored in the host side device, whether the sent data is data newly stored in the host side device."

Claim 58 recites "A computer-implemented method, comprising: first sending request information...; first receiving the request information...". It is not exactly clear what the steps being claimed are.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claims 1-2, 4-28 and 52-61 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schulhof et al. (US 5,572,442 hereinafter Schulhof) in view of Kaplan (US 5,963,916).**

As per claim 60, Schulhof discloses a data sending receiving system having a sending apparatus and a receiving apparatus, the data sending receiving system comprising: a first memory configured to store data (Figure 1, "18"); a first interface configured to send and receive data (Figure 1, "22"); a retrieval unit configured to retrieve the data stored in said first memory (Figure 1, "20" and [column:line] [6:53-61]); a first controller configured to control said first interface to receive request information for content from said receiving apparatus (Figure 1, "20" and [6:24-40]), wherein the retrieval unit is configured to retrieve the data stored in said first memory based on the request information ([6:24-40]), and said first interface is configured to send the data retrieved

by said retrieval unit ([6:62-57]); a second interface configured to send information and to receive data (Figure 1, "50"); a second memory configured to store data ([4:56-67]); and a second controller configured (1) to control said second interface to send said request information to said sending apparatus based on user input and to receive the data retrieved by said retrieval unit ([4:56-67]), wherein said first interface and said second interface are connected to an electronic communication network ([13:45-55]). Schulhof does not explicitly disclose including a plurality of content and supplementary information indicating a newness of the plurality of content; the second controller configured (2) to check whether the received data sent from said sending apparatus includes new content, by checking the supplementary information and (3) to add only the new content included in the received data to the second memory automatically based on the results of the checking ([19:12-22]). However, Kaplan teaches in ([19:12-22]) a time stamp, indicating newness, accompanying a broadcast node, checking the time stamp to determine new content and adding only the new content. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the invention as disclosed by Schulhof and include ensuring only new data is added as taught by Kaplan in order to reduce duplication of data.

As per claim 2, Schulhof further discloses wherein said second interface further includes a reproducing unit and wherein, when the results of the checking indicates data other than data newly stored in said first memory, said reproducing unit reproduces the data sent from the first interface ([4:56-57][5:1-5]).

As per claim 4, Schulhof does not explicitly disclose further comprising decision means for checking whether the data sent from said first memory is the data newly stored in said first memory. However, Schulhof discloses delivery of new daily material such as a daily newspaper which is transcribed every morning, digitized and sent to the library ([6:14-24]) and Kaplan teaches in ([19:12-22]) a time stamp, indicating newness, accompanying a broadcast node, checking the time stamp to determine new content and adding only the new content. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the invention as disclosed by Schulhof and include ensuring only new data is added as taught by Kaplan in order to reduce duplication of data.

As per claim 5, Schulhof further discloses wherein said second interface generates the request information from the user inclusive of data specifying an intention of the user to make payment and sends the generated information to said first interface ([7:54-67][8:1-4]).

As per claim 6, Schulhof further discloses wherein said first interface switches a sending mode to said second interface for data retrieved by said retrieval unit based on data specifying the intention of the user to make payment sent from the second interface ([7:54-67][8:1-4]).

As per claim 7, Schulhof further discloses wherein said first interface switches the sending mode to the second interface based on data specifying the intention of the user to make payment sent from the second interface when the data retrieved by said retrieval unit is the data newly stored in said first interface ([7:54-67][8:1-4]).

As per claim 8, Schulhof further discloses wherein said first interface sends to said second interface data newly stored in said first interface with a same data quality as a data quality in sending other data stored in said first memory when the data specifying the intention of the user to make payments for the request information from the user sent from the second interface indicates that the user is willing to make the payments ([7:54-67][8:1-4] and [9:10-25]).

As per claim 9, Schulhof further discloses wherein said first interface sends to said second interface data newly stored in said first interface with a data quality lower than a data quality in sending other data stored in said first memory when the data specifying the intention of the user to make payments for the request information from the user sent from the second interface indicates that the user is not willing to make the payments ([7:54-67][8:1-4] [9:10-25]).

As per claim 10, Schulhof does not explicitly disclose wherein said second interface generates the request information from the user inclusive of genre designation

information to send the generated information to said first interface. However, Schulhof discloses providing a variety of content such as news and entertainment ([2:28-35]) and Kaplan teaches provides data based on the genre requested by the user (e.g. Figure 5H). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the invention as disclosed by Schulhof and include in the provided programming, a further selection such as by genre as disclosed by Kaplan, in order to provide the user with a greater selection and user friendly product.

As per claim 11, Schulhof further discloses wherein said second interface, when reproducing data stored in said second memory, reproduces the data in a same playback state as a playback state for reproducing data other than the data newly stored in said first memory when the user is willing to make a payment ([7:54-67][8:1-4][9:10-25]).

As per claim 12, Schulhof further discloses wherein said second interface, when reproducing data stored in said second memory, sends information concerning the payment to said first interface when the user is willing to make the payment ([7:54-67][8:1-4][9:10-25]).

As per claim 13, Schulhof further discloses wherein said first interface performs accounting based on accounting information sent from said second interface ([7:54-67][8:1-4][9:10-25]).



As per claim 14, Schulhof further discloses wherein said first interface sends to said second interface data specifying that an accounting has come to a close and appends accounting data specifying that the accounting has come to a close to data for playback stored in second memory ([8:5-19]).

As per claim 15, Schulhof further discloses wherein said second interface switches the playback state of data stored in said second memory based on the data specifying that the accounting has come to a close ([8:5-19]).

As per claim 16, Schulhof further discloses wherein said second interface discontinues the playback state while reproducing data stored in said second memory when the user has no intention to make the payment ([9:27-36]).

As per claim 17, Schulhof does not explicitly disclose wherein said first interface sends to the retrieving unit the request information from the user containing the genre designation information sent from the second interface, and wherein said retrieval unit retrieves data stored in said first memory based on the request information from the user containing the genre designation information to send the retrieved data to the second interface. However, Schulhof discloses providing a variety of content such as news and entertainment ([2:28-35]) and Kaplan teaches provides data based on the genre requested by the user (e.g. Figure 5H). Therefore, it would have been obvious to

one of ordinary skill in the art at the time of the invention to modify the invention as disclosed by Schulhof and include in the provided programming, a further selection such as by genre as disclosed by Kaplan, in order to provide the user with a greater selection and user friendly product.

As per claim 21, Schulhof does not explicitly disclose wherein said controller includes a discriminating unit, based on the supplementary data appended to the sent data, configured to indicate that the data is data newly stored in the host side device, whether the sent data is data newly stored in the host side device. However, Schulhof discloses delivery of new daily material such as a daily newspaper which is transcribed every morning, digitized and sent to the library ([6:14-24]) and Kaplan teaches in ([19:12-22]) a time stamp, indicating newness, accompanying a broadcast node, checking the time stamp to determine new content and adding only the new content. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the invention as disclosed by Schulhof and include ensuring only new data is added as taught by Kaplan in order to reduce duplication of data.

As per claim 52, Schulhof further discloses wherein said retrieval unit retrieves said new content that is data that has been put on sale or publicized only recently ([6:14-23]).

As per claim 53, Schulhof further discloses wherein said retrieval unit retrieves said new content data that is data received within a preset time period from a date on which the data has been put on sale or publicized ([6:14-23]).

As per claim 54, Schulhof does not explicitly disclose further comprising decision means for checking whether said new content is data that is not received by said second interface. However, Schulhof discloses delivery of new daily material such as a daily newspaper which is transcribed every morning, digitized and sent to the library ([6:14-24]) and Kaplan teaches in ([19:12-22]) a time stamp, indicating newness, accompanying a broadcast node, checking the time stamp to determine new content and adding only the new content. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the invention as disclosed by Schulhof and include ensuring only new data is added as taught by Kaplan in order to reduce duplication of data.

As per claims 1, 18-20, 22-28, 55-59 and 61, claims 1, 18-20, 22-28, 55-59 and 61 recite substantially similar limitations to claims 2-17, 52-54 and 60 and are therefore rejected using the same art and rational set forth above.

Please Note: A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to

patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim.

### ***Response to Arguments***

Applicant's arguments with respect to claims 1, 2, 4-28 and 52-61 have been considered but are moot in view of the new ground(s) of rejection.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to HAJIME ROJAS whose telephone number is (571)270-5491. The examiner can normally be reached on EST. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Florian Zeender can be reached on (571)272-6790. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a

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/HAJIME ROJAS/

Examiner, Art Unit 3627

/F. Ryan Zeender/

Supervisory Patent Examiner, Art Unit 3627